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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,341	02/06/2004	Yasufumi Nakai	009679-064	4494
21839	7590	04/25/2005	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			LE, HOA VAN	
POST OFFICE BOX 1404			ART UNIT	
ALEXANDRIA, VA 22313-1404			PAPER NUMBER	
			1752	
DATE MAILED: 04/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,341

Applicant(s)

NAKAI ET AL.

Examiner

Hoa V. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 4-6, 30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7-29 with respect to the elected and applied species is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07 May 2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

This application is before the examiner for consideration on the merits.

A. Claims 1-31 are generic to a plurality of disclosed patentably distinct species comprising many possible chemical structures of the general formula (A) and general formula (B). Applicant is required under 35 U.S.C. 121 to elect a single disclosed chemical structure species for an initiation of a search, even though this requirement is traversed.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

B. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-29, drawn to a combined bleach and fixing (bleach-fixing or blixing) functional composition, classified in class 430, subclass 460.
- II. Claims 30-31, drawn to a bleach-fixing (desilvering) process, classified in class 430, subclass 393.

Inventions Group I and Groups II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different

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product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process of desilvering of an exposed and color developed silver halide color photographic can be practiced with another materially different product such as those known in the art or commercially available bleach-fixing compositions.

Because these inventions are distinct for the reasons given above and have acquired a separate status and can support separate patents as divided by applicants, restriction for examination purposes as indicated is proper.

C. During a telephone conversation with Mr. Roger H. Lee on 20 April 2005 a provisional election was made without traverse to prosecute the invention of the invention of Group I, claims 1-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 30-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. They will be allowed to be rejoined with their dependent material claim 1 when the material claim 1 is found to be allowable as requested.

D. On 20 April 2005, applicants also elect the imidazole species of compound "(1)" in claim 27 of the general formula (A) in claim 1. The elected imidazole has been considered and searched. The consideration and search are extended to the applied species. Others have not been considered, searched or examined until the elected and applied species are overcome.

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Accordingly, claims 4-6 are withdrawn from a consideration for now as being non-elected species of the general formula (B).

E. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 7-18 and 21-28 with respect to the elected and applied species are rejected under 35 U.S.C. 102(b) as being anticipated by Morigaki et al (5,270,148).

Morigaki et al disclose and teach a combined bleaching and fixing (bleach-fixing or blixing) functions by mixing chemical ingredients with water in the form of an aqueous solution having a pH of from 4-7. The chemical ingredients in the aqueous solution are up to 0.5 mol/l of a bleaching agent, up to 3.0 mol/l of a thiosulfate fixing agent, up to 10 mol/l of the elected imidazole species or the applied 2-methylimidazole or both of them, a about 0.35 mol/l of sulfite. Please see the whole disclosure of the applied reference especially at col.34:9-10, 36:47-48 and 60-63 and 67 to 37:1, 17-18, 48-49 and 56-59, 61:58 to 62:15.

Since Morigaki et al are reasonably disclosed and taught the claimed embodiments, the above claims are found to be anticipated by Morigaki et al.

F. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-20 and 29 with respect to the elected and applied species are rejected under 35 U.S.C. 103(a) as being unpatentable over Morigaki et al (5,270,14800) considered in view of Haye et al (6,727,051) and Papai (6,455,236).

Morigaki et al disclose and teach a combined bleaching and fixing (bleach-fixing or blixing) functions by mixing chemical ingredients with water in the form of an aqueous solution having a pH of from 4-7. The chemical ingredients in the aqueous solution are up to 0.5 mol/l of a bleaching agent, up to 3.0 mol/l of a thiosulfate fixing agent, up to 10 mol/l of the elected imidazole species or the applied 2-methylimidazole or both of them, a about 0.35 mol/l of sulfite. Please see the whole disclosure of the applied reference especially at col.34:9-10, 36:47-48 and 60-63 and 67 to 37:1, 17-18, 48-49 and 56-59, 61:58 to 62:15.

Morigaki et al disclose, teach and suggest the use of a sulfite but do not specify up to 0.8 mol/l as those in claims 19-20. Haye et al at col.5:47 is cited to show the known teaching and suggestion of the use of a sulfite in a bleaching-fixing composition as a known preservative agent in the art.

Morigaki et al disclose, teach and suggest a ready-to-use bleach-fixing solution but do not specify a bleach-fixing concentrate. Papai at col.2:58-60 is cited to show the known bleach-fixing concentrate for the advantage of reducing transportation and packaging costs.

Since the above references are all related to bleach-fixing compositions, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use or cite the suggested amount of a sulfite for a reasonable expectation of obtain a preservative result

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as disclosed, taught and suggested in Haye et al and use of cite a concentrated from for a reasonable expectation of obtaining a reduction in transportation and packaging cost as disclosed, taught, suggested and obtained in Papai.

G. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoa V. Le whose telephone number is 571-272-1332.

The examiner can normally be reached from 6:30 AM to 4:30 PM on Monday through Thursday and about the same time of most Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 571-272-1526.

Applicants may file a paper by (1) fax with a central facsimile receiving number 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoa V. Le
Primary Examiner
Art Unit 1752

HVL
21 April 2005

HOA VAN LE
PRIMARY EXAMINER
Hoa Van Le